IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of: Reed et al.	Group Art Unit: 1771
Serial No: 09/976,411	Examiner: Hai Vo
Filed: October 12, 2001	Our Customer ID: 22827
For: Medical Packaging Substrate	Our Account No: 04-1403
Sir:	Attorney Ref: NPI-30 (14845)

1. [ ] **NOTICE OF APPEAL**: Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated ____ of the Examiner twice/finally rejecting claims ____.
2. [X] **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy)
3. [ ] An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
4. [ ] Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. [ ] "Small entity" verified statement filed: [ ] herewith [ ] previously.
6. **FEE CALCULATION:**

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Petition is hereby made to extend the original due date of July 21, 2007 to cover the date of this paper and any enclosure for which the requisite fee is (1 month $120); (2 months $450); (3 months $1,020); (4 months $1,590), (5 months $2,160)		$120.00
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Date: August 21, 2007

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PATENT

ATTORNEY DOCKET NO: NPI-30 (14845)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Reed et al.	)	Examiner: Hai Vo
Serial No: 09/976,411	)	Art Unit: 1771
Filed: October 12, 2001	)	Confirmation No: 1102
Title: Medical Packaging Substrate	)	Deposit Account No: 04-1403
	)	Customer No: 22827

Mailstop Appeal Brief - Patents
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Arlington, VA 22313-1450

BRIEF ON APPEAL

Dear Sir:

In response to the communication dated March 14, 2007, for the above-captioned patent application, Appellant submits the following Brief on Appeal in accordance with 37 C.F.R. § 41.37.

1. Real Party in Interest

The real party in interest with respect to the above-captioned application and with respect to this appeal is Neenah Paper, Inc.

2. Related Appeals and Interferences

Appellant is not aware of any other prior or pending appeals, interferences or judicial proceedings that may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in this appeal.

3. Status of Claims

Claims 42-68, all of which are attached hereto in the Claims Appendix, are currently pending in the present application, including independent claims 42 and 59. Previously, claims 1-41 were canceled. Claims 42-68 (all the pending claims) are being appealed.

4. Status of Amendments

All amendments in this case have been entered.

5. Summary of Claimed Subject Matter

Independent claim 42 is directed to a medical packaging substrate comprising a paper-based web. The paper-based web is impregnated with a saturant comprising a latex polymer emulsion. The latex polymer emulsion comprises a polyacrylate having a glass transition temperature of -20°C or less. (See e.g., Appl. p. 7, ll. 19-25). The saturant is present at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fiber in the paper-based web. (See e.g., Appl. p. 17, ll. 26-31 and p. 18, ll. 1-12). Further, the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 95%. (See e.g., Appl. pp. 20-28).

Independent claim 59 is directed to a medical packaging substrate comprising a paper-based web. The paper-based web is impregnated with a saturant comprising a latex polymer emulsion. The latex polymer emulsion comprises a polyacrylate having a glass transition temperature of -29°C or less. (See e.g., Appl. p. 7, ll. 19-25). The saturant being present at an add-on level of from about 20 to about 70 dry parts per 100 dry parts of fiber in the paper-based web. (See e.g., Appl. p. 17, ll. 26-31 and p. 18, ll. 1-12). The medical packaging substrate exhibits a percent bacterial filtration efficiency

of at least about 95% and a Gurley Hill porosity of greater than about 15 sec/100 cc. (See e.g., Appl. pp. 20-28).

6. Grounds of Rejection to be Reviewed on Appeal

In the Office Action, claims 42-68 were finally rejected under *35 § 103* in view of U.S. Patent No. 5,191,734 to Weber, et al. in combination with Flick, "Water-Soluble Resins – An Industrial Guide (2nd ed.)" 1991, pgs 163-181.

7. Argument

I. Claims 42-68 are not obvious under 35 U.S.C. § 103(a) in view of Weber, et al. in view of Flick.

Weber, et al. discloses a biodegradable latex web material including a web of cellulose fibers saturated with a latex composition. The latex composition comprises a polyacrylate, nitrile rubber, natural rubber or combinations thereof. However, as admitted by the Office Action, Weber does not disclose the use of a polyacrylate latex having a glass transition temperature of -20°C or less. Thus, the Office Action cites Flick as disclosing the very Hycar products taught in the present application.

A. Even if combined, the cited references Do Not Disclose a "Medical Packaging Substrate"

Claims 42-68 are directed to a "medical packaging substrate", i.e., a material used in forming packages for the medical field, such as for packaging medical instruments and other devices that require sterilization. The claimed medical packaging substrates are specifically designed to allow for surgical instruments contained therein to become sterilized, while simultaneously acting as a good barrier to bacteria. Even if the above cited references are combined, a medical packaging substrate is simply not taught or even suggested.

Weber, et al. is directed to a material for use in agricultural mulch and row covers, bags, outer covers for personal care products (e.g., diapers, feminine pads, training pants, incontinence products, and wound dressings), surgical drapes, and gowns. Nevertheless, the Examiner continues to give no weight to the preamble.

When the preamble recites a limitation in the context of the entire claim, it should be read as if in the balance of the claim. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) (The claim at issue was directed to a driver for setting a joint of a threaded collar; however, the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." Id. at 1073,

828 F.2d at 754.); *Pitney Bowes, Inc. v. Hewlett-Packard Co.,* 182 F.3d 1298, 1305 (Fed. Cir. 1999) (holding that if, "when read in the context of the entire claim," the preamble "recites limitations of the claim or ... is 'necessary to give life, meaning, and vitality' to" the claim, the preamble language is properly treated as limiting);

In considering whether a preamble limits a claim, the preamble is analyzed to ascertain whether it states a necessary and defining aspect of the invention, or is simply an introduction to the general field of the claim. The preamble serves to focus the reader on the invention that is being claimed. See, e.g., *On Demand Machine Corp. v. Ingram Industries, Inc.*, 442 F.3d 1331, 1344 (Fed. Cir. 2006) (We conclude that the preamble in this case necessarily limits the claims, in that it states the framework of the invention); *Kropa v. Robie,* 38 C.C.P.A. 858, 187 F.2d 150, 152 (1951) (the court aptly described the inquiry as whether the preamble is "necessary to give life, meaning and vitality to the claims or counts."); *Poly-America, L.P. v. GSE Lining Tech., Inc.,* 383 F.3d 1303, 1309-10 (Fed. Cir. 2004) (the specification described the "blown-film" as a fundamental characteristic of the invention, and its use in the preamble limited the claims); *General Elec. Co. v. Nintendo Co., Ltd.,* 179 F.3d 1350, 1361-62 (Fed. Cir.1999) (where the specification made clear that the invention was a mode of display of binary data on a raster scanned display device rather than all display devices, the preamble language "displaying a pattern on a raster scanned display device by mapping bits" was a claim limitation).

In the present application, the phrase "medical packaging substrate" acts as a limitation when read in the context of the present claims. Moreover, upon review of the entirety of the present application, it is evident that such a medical packaging substrate

is what the present inventors actually invented and intended to encompass in the present claims. As such, the Examiner is must consider the recitation of "medical packaging substrate" as a limitation in the claim. Thus, for at least these reasons, Applicants respectfully submit that the present claims patentably define over Weber, et al., either alone or in any combination.

B. The cited references do not disclose a Bacterial Filtration Efficiency of At Least About 95%.

Additionally, the cited references, either alone or in combination fail to disclose or suggest the claimed "Bacterial Filtration Efficiency." Specifically, Weber, et al. fails to expressly disclose the claimed bacterial filtration efficiency. Nevertheless, the Examiner previously asserted that the value is "inherent."

To establish inherency, the evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing *may* occur or be present in the reference is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Simply stated, inherency may not be established by probabilities or possibilities.

In this case, the basis for the inherency rejection was said to hinge on the fact that the product and process of the claims and Weber, et al. are the same. However, Weber, et al. does *not* disclose the same materials used in the present claims, e.g., a polyacrylate latex with a glass transition temperature of -20°C or less. In fact, the Examiner previously conceded that "the basis for inherency could *not* be established" if

a reference failed to disclose the claimed glass transition temperature. (Office Action of 02/24/05, pp. 3-4) (Emphasis added).

In any event, Applicants note that a variety of other aspects of the claimed medical packaging substrate may influence its % BFE, e.g., the add-on level, the type of web, and so forth. In view of the wide variety of parameters that may be altered to influence % BFE, there is simply no indication that Weber, et al. would necessarily result in the claimed % BFE, even if modified as attempted by the Office Action. Thus, for at least the reasons set forth above, Applicants respectfully submit that Weber, et al. does not disclose the claimed % BFE.

C. One of ordinary skill in the art would not have modified Weber, et al. with the teachings of Flick as attempted by the Office Action.

As previously pointed out, Weber, et al. does not disclose a polyacrylate having a *glass transition temperature of -20°C or less* as required by the present claims. As such, the Office Action cites to Flick for disclosing the same polyacrylates disclosed by the present application having a glass transition temperature of -20°C or less. However, Applicants respectfully submit that no reason exists for one of ordinary skill in the art to use the polyacrylate latex designated Hystretch ® V-43 in the web materials of Weber, et al.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "[T]he examiner bears the initial burden, on

review of the prior art or on any other ground, of presenting a prima facie case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, "'there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to modify the teachings of the references to arrive at the claimed invention. See e.g., In re Regel, 188 U.S.P.Q. 132 (C.C.P.A. 1975).

Although Weber, et al. discloses that other types of latexes having a glass transition temperature of between –50 °C and 20 °C, the only polyacrylate latexes disclosed by Weber, et al. have a glass transition temperature of –15 °C or greater. Weber, et al. discloses only non-polyacrylate latexes, such as a nitrile rubber latex, having a glass transition temperature of less than –15 °C. Thus, it would not have made sense to one of ordinary skill in the art to use a polyacrylate latex having a glass transition temperature of less than –15 °C.

Furthermore, Applicants respectfully submit that the only motivation to use the Hystretch ® V-43 improperly stems from the present application. Without the disclosure

of the present specification, no reason exists for one of ordinary skill in the art to use the polyacrylate latex designated Hystretch ® V-43. The polyacrylate latex designated Hystretch ® V-43 is one of the particular polyacrylate latexes disclosed by the present application. See, e.g., pg. 8, lines 15-28. As described in the specification, such polyacrylates exhibit the most desirable bacterial filtration efficiencies in comparison to other binder systems. See, e.g., pg. 16, lines 18-22.

Applicants note that it is improper to use a patent applicant's own specification to provide the only suggestion for modifying the prior art. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See Grain Processing Corp. v. American Maize-Products, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 12 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Additionally, The U.S. Supreme Court recently reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d at 1397. See also, Graham v. John Deere Co., 383 U.S. at 36, 148 USPQ at 474.

Plainly, the Examiner's only incentive or motivation for so modifying Weber, et al. in the manner suggested in the Office Action results from using Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art, which is improper under 35 U.S.C. § 103. Accordingly, it is respectfully submitted that any such modification of the cited references relies on the impermissible use of

hindsight, which cannot be successfully used to support a *prima facie* case of obviousness.

Respectfully submitted,

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CLAIMS APPENDIX

Claims Involved in the Appeal:

1-41. (Cancelled)

42. (Rejected) A medical packaging substrate comprising a paper-based web, the paper-based web being impregnated with a saturant comprising a latex polymer emulsion, the latex polymer emulsion comprising a polyacrylate having a glass transition temperature of -20°C or less, the saturant being present at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fiber in the paper-based web, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 95%.

43. (Rejected) The medical packaging substrate of claim 42, wherein the polyacrylate has a glass transition temperature of about -29°C or less.

44. (Rejected) The medical packaging substrate of claim 42, wherein the polyacrylate has a glass transition temperature of about -43°C or less.

45. (Rejected) The medical packaging substrate of claim 42, wherein the polyacrylate has a glass transition temperature of about -60°C or less.

46. (Rejected) The medical packaging substrate of claim 42, wherein the saturant is present at an add-on level of from about 20 to about 70 dry parts per 100 dry parts of fiber in the paper-based web.

47. (Rejected) The medical packaging substrate of claim 42, wherein the saturant is present at an add-on level of from about 20 to about 60 dry parts per 100 dry parts of fiber in the paper-based web.

48. (Rejected) The medical packaging substrate of claim 42, wherein the saturant is present at an add-on level of from about 30 to about 50 dry parts per 100 dry parts of fiber in the paper-based web.

49. (Rejected) The medical packaging substrate of claim 42, wherein the latex polymer emulsion comprises from about 60 to about 100 percent, on a dry weight basis, of the polyacrylate.

50. (Rejected) The medical packaging substrate of claim 42, wherein the latex polymer emulsion comprises a blend of the polyacrylate and a polymer that is not a polyacrylate.

51. (Rejected) The medical packaging substrate of claim 42, wherein the saturant comprises an additional latex polymer emulsion.

52. (Rejected) The medical packaging substrate of claim 51, wherein the additional latex polymer emulsion has a glass transition temperature of -20°C or less.

53. (Rejected) The medical packaging substrate of claim 51, wherein the additional polymer emulsion has a glass transition temperature of about -29°C or less.

54. (Rejected) The medical packaging substrate of claim 51, wherein the additional polymer emulsion has a glass transition temperature of about -43°C or less.

55. (Rejected) The medical packaging substrate of claim 51, wherein the additional polymer emulsion has a glass transition temperature of about -60°C or less.

56. (Rejected) The medical packaging substrate of claim 42, wherein the medical packaging substrate exhibits a Gurley Hill porosity of greater than about 15 sec/100 cc.

57. (Rejected) The medical packaging substrate of claim 42, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 98%.

58. (Rejected) The medical packaging substrate of claim 42, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 99%.

59. (Rejected) A medical packaging substrate comprising a paper-based web, the paper-based web being impregnated with a saturant comprising a latex polymer emulsion, the latex polymer emulsion comprising a polyacrylate having a glass transition temperature of -29°C or less, the saturant being present at an add-on level of from about 20 to about 70 dry parts per 100 dry parts of fiber in the paper-based web, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 95% and a Gurley Hill porosity of greater than about 15 sec/100 cc.

60. (Rejected) The medical packaging substrate of claim 59, wherein the polyacrylate has a glass transition temperature of about -43°C or less.

61. (Rejected) The medical packaging substrate of claim 59, wherein the polyacrylate has a glass transition temperature of about -60°C or less.

62. (Rejected) The medical packaging substrate of claim 59, wherein the saturant is present at an add-on level of from about 20 to about 60 dry parts per 100 dry parts of fiber in the paper-based web.

63. (Rejected) The medical packaging substrate of claim 59, wherein the saturant is present at an add-on level of from about 30 to about 50 dry parts per 100 dry parts of fiber in the paper-based web.

64. (Rejected) The medical packaging substrate of claim 59, wherein the latex polymer emulsion comprises from about 60 to about 100 percent, on a dry weight basis, of the polyacrylate.

65. (Rejected) The medical packaging substrate of claim 59, wherein the saturant comprises an additional latex polymer emulsion.

66. (Rejected) The medical packaging substrate of claim 65, wherein the additional latex polymer emulsion has a glass transition temperature of -20°C or less.

67. (Rejected) The medical packaging substrate of claim 59, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 98%.

68. (Rejected) The medical packaging substrate of claim 59, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 99%.

9. Evidence Appendix

None.

10. Related Proceedings Appendix

None.